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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,978	09/11/2003	Yasuo Sakaba	WAKA 20.630	8563
26304	7590	01/04/2005	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			DANG, PHUC T	
			ART UNIT	PAPER NUMBER
			2818	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/661,978	Applicant(s) SAKABA ET AL.	
	Examiner PHUC T DANG	Art Unit 2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-10, 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>093003</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Oath/Declaration

1. The oath/declaration filed on September 11, 2003 is acceptable.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The office acknowledges receipt of the following items from the applicant:

Information Disclosure Statement (IDS) filed on September 30, 2003.

Specification

4. The specification has been checked to the extent necessary to determine the presence of all possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 and 11 are rejected under 35 U.S.C. 102 (e) as being anticipated by Harima et al., hereinafter "Harima" (U.S. 2004/0036437 A1).

Regarding claim 1, Harima discloses a method of manufacturing a mounting substrate accommodating therein an electronic component for use in a surface mount crystal oscillator and adapted to be Joined to a bottom surface of a crystal unit, comprising the steps of:

designing a recess (16, Fig. 2A) with a bottom wall (8b, Fig. 2A) and a frame wall (9, Fig. 2A) having an opening (17, Fig. 2A);

placing the electronic component (12, Fig. 2A) in the recess;

filling the recess with a resin (15, Fig. 2A) for protecting the electronic component; and

after the resin is cured, removing at least a portion of the frame wall (9, Fig. 2B).

Regarding claims 2-3, Harima discloses the mounting substrate has a substantially rectangular planar shape (2, Fig. 2B), and the frame wall (9, Fig. 2B) is removed along a pair of longer sides of the mounting substrate.

Regarding claim 3, Harima discloses the electronic component comprises an IC chip (12, Fig. 2A).

Regarding claim 11, Harima discloses a surface mount crystal oscillator comprising:

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a crystal unit (1, Fig. 1A); and

a mounting substrate (2, Fig. 1A) manufactured by a method according to claim 1 and joined to a bottom surface (8b, Fig. 1A) of the crystal unit (1, Fig. 1A).

Allowable Subject Matter

6. Claims 4-10 and 12-13 would be allowed.

The following is a statement of reason for the indication of allowable subject matter:

Claims 4-10 and 12-13 are considered allowable since the prior art of record and the considered pertinent to the applicant's disclosure does not teach or suggest the claimed invention having a step of severing the sheet substrate including the resin in position between adjacent ones of the electronic components, into the mounting substrate after filling the recess with a resin for protecting the electronic components.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuc T. Dang whose telephone number is 571-272-1776. The examiner can normally be reached on 8:00 am-5:00 pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David C. Nelms can be reached on (571) 272-1787. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and Final communications.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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Phuc T. Dang

PD *Phuc T. Dang*

Examiner

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